

## REMARKS/ARGUMENTS

### *Status of the Application*

In the Non-Final Office Action, Claims 1-6, 8-10, and 12-13 were rejected. In the present response, Claim 1 was amended to remove “body fittings” from the substrate list and Claim 13 was amended to delete the term “only” from the claim. Thus, Claims 1-6, 8-10, and 12-13 are pending. No new matter was added.

### *Rejections Under 35 U.S.C. § 112, 2<sup>nd</sup> Paragraph*

Claim 13 was rejected under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants’ amendment to Claim 13 should obviate this rejection.

### *Rejections Under 35 U.S.C. § 102(b)*

Claims 1-3, 5-6, 8-10, and 13 were rejected under 35 U.S.C. § 102(b) as being anticipated by Rattee *et al.* (U.S. Patent No. 4,315,790). Applicants respectfully traverse this rejection.

The MPEP states that “[a] genus does not always anticipate a claim to a species within the genus.” MPEP § 2131.02(A). While “the disclosure of a small genus may anticipate the species of that genus even if the species are not themselves recited,” *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1380 (Fed. Cir. 2001), and “when the species is clearly named, the species claim is anticipated no matter how many other species are additionally named,” MPEP § 2131.02(A), neither of these are the case here. The genus of Rattee *et al.* is exceptionally broad, covering “any flexible substrate which needs to be decorated like a textile” (col. 1, lines 10-11). With such a statement, one could envision that Rattee *et al.*’s flexible substrate is *anything* that is not rigid. The disclosure of Rattee *et al.* also does not clearly name any species related automobiles,<sup>1</sup> only naming “textile fabrics” as a preferred subgenus (col. 1, lines 4-6). Applicants’ substrates, on the other hand, are restricted to automotive bodies and

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<sup>1</sup> The only species that appear to be named in Rattee *et al.* are types of fabrics found in the examples, such as a knitted cotton T-shirt, mercerized cotton, cotton/polynosic rayon blend, woven cotton, and knitted polynosic rayon.

body parts, a far narrower group than that disclosed in Rattee *et al.* and not part of the textile fabric subgenus. Applicants thus respectfully submit that the Rattee *et al.* disclosure fails to anticipate the Claim 1 invention. As such, the dependent claims thereto should also be novel.

***Rejections Under 35 U.S.C. § 103(a)***


Claims 4 and 12 were rejected under 35 U.S.C. § 103(a) as being obvious over Rattee *et al.* Applicants respectfully traverse these rejections.

Similar to that discussed above, to establish a *prima facie* case of obviousness, there must be some suggestion in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference to produce Applicants' claimed invention. MPEP § 2143.01(I). A broad disclosure of the decoration of "any flexible substrate which needs to be decorated like a textile" is *not* a suggestion to coat the automotive bodies, body parts, and body fittings claimed by Applicants. See generally MPEP § 2144.08(II) ("The fact that a claimed species or subgenus is encompassed by a prior art genus is not sufficient by itself to establish a *prima facie* case of obviousness."). Nothing in the remainder of Rattee *et al.* provides such a suggestion. Because a *prima facie* case of obviousness cannot be made out against Claim 1, Applicants respectfully submit that dependent Claims 4 and 12 cannot be obvious over Rattee *et al.*

**Summary**

In view of the foregoing amendments and remarks, Applicants submit that this application is in condition for allowance. In order to expedite disposition of this case, the Examiner is invited to contact Applicants' representative at the telephone number below to resolve any remaining issues. Should there be a fee due which is not accounted for, please charge such fee to Deposit Account No. 04-1928 (E.I. du Pont de Nemours and Company).

Respectfully Submitted,

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